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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,563

06/02/2006

Michael Gavin Proctor

71,049-012

6206

27305

7590

06/29/2009

HOWARD & HOWARD ATTORNEYS PLLC
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EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

06/29/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,563	Applicant(s) PROCTOR ET AL.	
	Examiner Margaret G. Moore	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/27/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 9, 11 to 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 9, 11 to 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/7/09</u> . | 6) <input type="checkbox"/> Other: _____ |

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/27/09 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 to 9 and 11 to 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woerner et al. in view of Cornelius et al.

This rejection relies on the rationale of record. As such this will not be repeated. Applicants' traversal is not persuasive.

Applicants argue that, first and foremost, both the patents teach away from the invention because they require reinforcing fillers. Applicants' response requested that the Examiner review the Declaration to "better understand the Applicant's reasoning based on the opinion of one of high skill in the art of silicone rubber development".

While the Declaration by Inventor Proctor argues that reinforcing fillers must be included for the silicone elastomer to be useful, the Examiner does not agree. She notes that Woerner et al. (the '458 patent) not only indicate that such fillers are not required, but they actually produce and test many silicone elastomer sheets in the working examples that do not include silica or any reinforcing filler. See for instance Example 9. Thus while one of applicants' main arguments is that '458 requires a reinforcing filler while the claimed composition is free of reinforcing fillers, the Examiner maintains her position that '458 does not require such fillers. In fact '458 prepares and tests various elastomer compositions that are free of reinforcing fillers. The Examiner cannot base any unobviousness of the claims on a conclusion by applicants that is contradicted by the prior art teaching.

With regard to the Cornelius et al. reference (the '141 patent), applicants argue that the '141 patent uses white clay merely as a heat stability additive without any explanation of any reinforcing effect whatsoever. They conclude then that there is no "expectation" of any "known" benefits based on any "teachings" in the '141 patent. The Examiner disagrees since the "expectation" of any "known" benefits based on any "teachings" in the '141 patent is the expectation of improved heat stability, as disclosed by '141.

Thus since '458 teaches the addition of a clay filler, the skilled artisan would have been motivated to select a kaolin, or white clay filler, not only to obtain the properties disclosed in '458 but also with the expectation of obtaining improved heat stability, as found in the '41 reference.

Applicants argue that '141 requires a reinforcing filler but the Examiner maintains that this would not lead the skilled artisan away from a reasonable expectation that the white clay alone would have the known properties and benefits disclosed by the prior art.

Applicants conclude that even combined the resultant composition would always include a reinforcing filler. The Examiner does not agree with this argument. The Declaration by Inventor Proctor argues various benefits and results that are unobvious over the prior art but applicants have not supported these assertions with clear and conclusive evidence.

Applicants' arguments that the claimed kaolin acts as a semi-reinforcing filler and that this is not suggested by the prior art or the fact that the surface of the kaolin is treated for a different reason than in the inventive composition are not persuasive. On one hand, the Examiner notes that the treated kaolin per se in '141 is the same as that claimed. On the other hand, the Examiner notes that a prima facie case of obviousness (for a composition) does not require the solution of the same problem or recognition of the same advantages as the applicants invention.

In view of this, the Examiner does not find applicants' response sufficient to overcome the obviousness rejection of record.

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/
Primary Examiner, Art Unit 1796

mgm
6/24/09